

REMARKS

Claims 1-41 are pending in the application. Claims 1-41 stand rejected by the examiner. Assignee traverses the rejections of the claims. Claims 42-65 have been added herein.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 4, 6, and 35 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the office action maintained that applicant's specification does not provide a bridge between the steps in these claims. Assignee respectfully disagrees, but to expedite prosecution of this application, assignee has amended claims 1, 4, 6, and 35 to clarify the bridge between the steps in these claims. For example, the step of determining accesses to the product page resulting from the link traversals to the product page has been inserted between the determining step and the charging step of claim 1. In addition, the subject matter of claim 3 has been added to claim 1 that further describes the charging step.

With respect to claim 4, the step of determining accesses to the page resulting from the link traversals from the advertisement to the page has been inserted between the determining step and the measuring step.

With respect to claim 6, the step of determining number of accesses to the page resulting from the link traversals from the first document to the second document has been inserted between the determining link traversals step and the charging step.

With respect to claim 35, the limitation that the access history is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID has been inserted between the producing step and the providing step.

In view of the amendments to claims 1, 4, 6, and 35, assignee respectfully requests that the instant rejections of these claims be withdrawn and the claims proceed to issuance.

Specification

The office action contained an objection to the disclosure because the specification incorporated by reference essential subject matter. Assignee has amended herein the specification to contain the non-limiting example from the incorporated by reference patent that illustrates an environment related to measurement of sales within a computer network sales system. In view of the amendment to the specification, assignee respectfully requests that the instant objection be withdrawn and the application should proceed to issuance.

New Claims

Claims 42-65 have been added herein. New claims 42-51 depend directly or indirectly from the previously presented claim 40. The subject matter of new claims 42-51 is based upon subject matter previously presented in dependent claims 13-22.

New claim 52 is an independent claim whose subject matter is based upon a combination of claims 1 and 2 as they were presented in the previous response. New claims 53-62 depend directly or indirectly from claim 52. The subject matter of new

claims 53-62 is based upon subject matter previously presented in dependent claims 13-22.

New claim 63 is an independent claim directed to a method of charging for advertising and whose subject matter is based upon independent claim 5. New claim 64 is a means-plus-function independent claim that corresponds to claim 52. New claim 65 is a means-plus-function independent claim that corresponds to claim 63.

Claim Rejections - 35 U.S.C. § 102

The pending claims stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ferguson et al., U.S. Patent No. 5,819,092 (hereinafter referred to as Ferguson). The office action also mentioned on page 3 that the examiner disagrees with assignee's position provided in the prior office action response that the Welz reference should not be considered prior art and instead should have an effective date of October 1994 (Welz: Gary Welz, The Media Business on the WWW: The Price and Value of Advertising on the WWW). Assignee respectfully disagrees with the rejections based upon Ferguson and that Welz has an effective date of October 1994. However to expedite prosecution of this application, assignee has attached to this Amendment at Schedule 1 a Declaration of Prior Invention Under 37 C.F.R. § 1.131 whose substance had been used in the previous response to overcome certain cited references (e.g., the Catledge and Novick references). In view of the § 1.131 affidavit, assignee respectfully requests that the instant rejections be withdrawn and this case proceed to issuance.

The claims are also patentable over the cited references. For example, dependent claims 12-39 are directed to activities resulting from traversing from a first document

(e.g., an advertisement page) to a second document (e.g., a product page). The Ferguson reference does not disclose that charging is based upon traversing from a first document (e.g., an advertisement page) to a second document (e.g., a product page). Rather the Ferguson reference is directed to specifying “how usage fees (if any) should be levied and paid to content providers and users, based on usage of the online service” and how “advertisers can be charged to place advertisements on an online service.” (See Ferguson, col. 18, lines 31-37). Because of such differences, these dependent claims are allowable and should proceed to issuance.

CONCLUSION

For the foregoing reasons, assignee respectfully submits that the pending claims are allowable. Therefore, the examiner is respectfully requested to pass this case to issue.

Respectfully submitted,

By: 

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SCHEDULE 1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Levergood et al.
Application No.: 09/548,235
Filing Date: April 12, 2000
Title: Web Advertising Method
Art Unit: 2155
Examiner: Patrice L. Winder
Docket No.: 432383-600011

Declaration of Prior Invention to Overcome Cited References Under 37 C.F.R. § 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
on January 25, 2007

By: Kathie Hopgood

Sir:

This Declaration is submitted to establish invention of the claimed subject matter of this application prior to October 1994 (the “effective date”).

We, Thomas Mark Levergood, Lawrence C. Stewart, Stephen Jeffrey Morris, Andrew C. Payne, and George Winfield Treese, inventors of the subject matter described and claimed in this application, titled “Web Advertising Method” declare as follows:

1. Prior to the effective date, Messrs. Stewart, Payne and Treese engaged in discussions regarding the development of technology for an Internet-based electronic commerce system for Open Market Inc. (“OMI”), the original assignee of this application. Messrs. Morris and Levergood joined OMI in January 1995. Prior to the effective date and as shown on page 4 of Exhibit A, a document (with Andrew Payne’s name at the top of the document) describes an Internet web-based service for customers and advertisers. The web-based service can provide web pages for customers (e.g., web pages containing news and advertisements). The web-based service can provide advertisers with a channel to potential customers. Exhibit A shows conception of claim 1 before the effective date. (The redacted date in Exhibit A is prior to the effective date.) More specifically, Exhibit A discusses “*a method of charging for advertising on the Web*” (as recited in claim 1), such as on page 3 of Exhibit A: “We can get money from users and advertisers” and “We can charge for placing ads into user’s newspapers. We can have several charging models.” Exhibit A discloses “*determining link traversals from an advertisement to a product page*” and “*determining accesses to the product page resulting from the link traversals to the product page*” (as recited in claim 1), such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

Exhibit A discloses “*charging for advertising based on said determined accesses to the product page*” and “*wherein charging for advertising is based on number of sales resulting from a path including an advertising page*” (as recited in claim 1), such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

2. Exhibit A shows conception of claim 4 before the effective date. More specifically, Exhibit A discusses “*determining link traversals leading from an advertisement to a page*” and “*determining accesses to the page resulting from the link traversals from the advertisement to the page*” (as recited in claim 4) such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

Exhibit A discloses “*measuring the number of sales resulting from the determined accesses from the advertisement to the page*” (as recited in claim 4), such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

3. Exhibit A shows conception of claim 5 before the effective date. More specifically, Exhibit A discusses “*determining link traversals leading from an advertisement to a*

page” and “determining accesses to the page resulting from the link traversals from the advertisement to the product page” such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

Exhibit A discloses “*measuring the number of transactions resulting from the accesses from the advertisement to the page*” (as recited in claim 5), such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

4. Exhibit A shows conception of claim 6 before the effective date. More specifically, Exhibit A discusses the limitations of claim 6 (e.g., “*tracking access history, including a link sequence through which a document is accessed; determining, based on the access history, link traversals from a first document to a second document; determining number of accesses to the page resulting from the link traversals from the first document to the second document; and charging for advertising based on the determined number of accesses to the second document*”). For example, Exhibit A discusses the limitations of claim 6 on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

5. Exhibit A shows conception of claim 7 before the effective date. More specifically, Exhibit A discusses *“wherein a link traversal is determined responsive to two entries in the access history, a first entry corresponding to a request from a given user for the first document and a second entry corresponding to a request from the given user for the second document,”* such as on pages 3 and 4 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

[...]

6. Exhibit A shows conception of claim 8 before the effective date. More specifically, Exhibit A discusses *“wherein the first document is an advertising page and the second document is a product page,”* such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

7. Exhibit A shows conception of claim 9 before the effective date. More specifically, Exhibit A discusses “*counting the number of sales resulted from a traversed path which includes the advertising page, wherein charging for advertising is based on the number of said sales,*” such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

8. Exhibit A shows conception of claim 10 before the effective date. More specifically, Exhibit A discusses “*counting the number of purchases resulting from link traversals from the advertisement to the second page, the number of such purchases being a measure of advertising effectiveness,*” such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

9. Exhibit A shows conception of claim 11 before the effective date. More specifically, Exhibit A discusses “*counting the number of transactions resulting from link traversals from the advertisement to the second page, the number of such purchases being a measure of advertising effectiveness,*” such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

10. Exhibit A shows conception of claim 40 before the effective date. More specifically, Exhibit A discusses "*means for determining link traversals leading to a page and means for charging for advertising based on link traversals to the page,*" such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

11. Exhibit A shows conception of claim 41 before the effective date. More specifically, Exhibit A discusses the limitations of claim 41 (e.g., "*means for tracking access history, including a link sequence through which a document is accessed; means for determining, based on the access history, link traversals from a first document to a second document; means for determining a number of such determined link traversals leading from the first document to the second document; and means for charging for advertising based on the number of link traversals to the second document*"), such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

12. Exhibit A shows conception of claim 52 before the effective date. More specifically, Exhibit A discusses “*determining link traversals from an advertisement to a product page*” and “*determining accesses to the product page resulting from the link traversals to the product page,*” such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

Exhibit A discloses “*charging for advertising based on said determined accesses to the product page*” and “*wherein charging for advertising is based on number of accesses from the advertisement to the product page*” (as recited in claim 52), such as on page 3 of Exhibit A:

We can charge for placing ads into user's newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

13. Exhibit A shows conception of claim 63 before the effective date. More specifically, Exhibit A discusses the limitations of claim 63 (“*determining link traversals leading from an advertisement to a page; determining accesses to the page resulting from the link*”

traversals from the advertisement to the page; measuring the number of transactions resulting from the determined accesses of the page; and charging for advertising based upon said measuring of the number of transactions”), such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

14. Exhibit A shows conception of claim 64 before the effective date. More specifically, Exhibit A discusses the limitations of claim 64 (“*means for determining link traversals from an advertisement to a product page; means for determining accesses to the product page resulting from the link traversals to the product page; and means for charging for advertising based on said determined accesses to the product page; wherein charging for advertising is based on number of accesses from the advertisement to the product page*”), such as on page 3 of Exhibit A:

We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

15. Exhibit A shows conception of claim 65 before the effective date. More specifically, Exhibit A discusses the limitations of claim 65 (e.g., “*means for determining link traversals leading from an advertisement to a page; means for determining accesses to the page resulting from the link traversals from the advertisement to the page; means for measuring the*

number of transactions resulting from the determined accesses of the page; and means for charging for advertising based upon said measuring of the number of transactions”), such as on page 3 of Exhibit A:

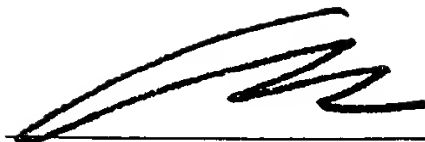
We can charge for placing ads into user’s newspapers. We can have several charging models.

[...]

- per referral: for ads that include hypertext links to more information, we can we can [sic] build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user’s reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

16. Exhibit B contains an e-mail message from an inventor (Thomas M. Levergood) discussing review of the application which evidences due diligence from prior to the effective date to the filing of the application.

17. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By: 

Andrew C. Payne

Date: 1/22/07

By: _____
Lawrence C. Stewart

Date: _____

SEE ATTACHED

By: _____
George Winfield Treese

Date: _____

By: _____
Thomas Mark Levergood

Date: _____

By: _____
Stephen Jeffrey Morris

Date: _____

By: _____ Date: _____
Andrew C. Payne

By:  Date: 1/18/07
Lawrence C. Stewart

By: _____ Date: _____
George Winfield Treese

SEE ATTACHED

By: _____ Date: _____
Thomas Mark Levergood

By: _____ Date: _____
Stephen Jeffrey Morris

By: Andrew C. Payne Date: _____
SEE ATTACHED

By: Lawrence C. Stewart Date: _____

By: George Winfield Treese Date: 1/19/2007

By: Thomas Mark Levergood Date: _____
SEE ATTACHED

By: Stephen Jeffrey Morris Date: _____

By: Andrew C. Payne Date: _____

By: Lawrence C. Stewart Date: _____

By: George Winfield Treese Date: _____

By: Thomas Mark Levergood Date: January 22, 2007

By: Stephen Jeffrey Morris Date: _____

SEE ATTACHED

By: Andrew C. Payne Date: _____

By: Lawrence C. Stewart Date: _____
SEE ATTACHED

By: George Winfield Treese Date: _____

By: Thomas Mark Levergood Date: _____

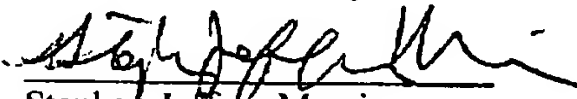
By:  Date: 1/15/07
Stephen Jeffrey Morris

EXHIBIT A

CustomNews: the personalized news source


Andrew Payne

This note describes a potential Open Market service offering: CustomNews. *Can someone think of a better name?*

The basic idea is for us to create custom home pages (or newspapers) for our customers. If we have a profile of their interests, we can select information, news, and advertisements and compose an custom on-line newspaper. The newspaper could be composed daily, hourly, or on-the-fly.

This service helps people stay informed. The Internet is an overwhelming place. It is hard enough to find something particular. It is nearly impossible to stay informed and track the constant stream of information.

This service offers value at both ends: to users, and to advertisers. Customers get a service that helps them manage information overload. Advertisers get a channel to potential customers.

Customer's View

We do two things for the user:

- Selection: We select information from a wide range of sources that is most relevant to the user, based on what they have told us they are interested in.
- Presentation: We arrange and format the selected items in a way that best addresses the user's interests. This process has several subcomponents:
 - Ordering: in what order should items be presented? Important items (headlines) might come first. Related items should be clustered together (all finance items on their own page, all items about DEC grouped together).
 - Emphasis: we can use presentation features (fonts, color, special graphics) to match the emphasis with the importance to the user
 - Content: what part of selected info items ends up being presented? Possibilities range from including the entire item to only including a pointer to the item. The choice depends on the user's preferences and the item. Small items (stock quotes) might be in-lined. Larger items such as news articles might be referenced by headline or headline and some subset of content (such as headline and first paragraph).

The goal is to show the user exactly what he wants to see, in the manner he wants to see it.

Advertiser's View

For the advertisers, we are creating a channel to customers.

Such a channel doesn't exist on the Internet today. Mass mailings and postings usually result in a cultural backlash. Weak channels are starting to emerge in the form of on-line indexes ("yellow pages"), but these methods depend on customer "pull" of information, and aren't suited to short-term advertising like sales.

XXX: compare to pure advertising channel (aka Dave's stuff). Would people actually sign up for an ad channel, even if it were free? If we did build an ad channel, how hard would it be for someone to build a competing, but compatible channel?

Business and Marketing Issues

This service has several nice business and marketing properties.

We "own" the customers.

For each customer, we have an entrenched relationship because we own their profile. Without this sort of inertia, there's no way to build and keep a long-term business on the Internet.

We own the channel to the customers.

Ideally, this is a frequent use service: our customers would be reading newspapers daily. We control what information that they see in their pages, which gives us a channel for delivering advertising.

Implementing this service is non-trivial.

This is a little more work than just putting up a few Web pages for everyone to read, so we are differentiated from the two-man consulting companies that are putting people on the Internet as fast as they can. Also, some of the technology for newspaper selection and composition might be patentable.

Fewer people are worrying about this problem.

Many are worrying about the problem of locating things on the Internet, and competition in that area is stiff judging by the number of directory services that are springing up. On the other hand, few are worrying about this problem of presenting customized, dynamic information to users. If we can solve it, and solve it early, we may create our own market.

Even a simple implementation has value: we can offer something early, and build incrementally.

We can start out with a basic news-clipping service, and gradually add more features over time. Ideally, we could cross-link various services in such a way that the whole is greater than the sum of the parts.

How we can make money

We can get money from users and advertisers.

For users, we charge for providing the service. We could charge a subscription amount and customers can use the service as much as they'd like for that amount. The amount might be fixed or depend on:

- the complexity of profile (complexity costs more)
- the size of the resulting newspaper

Or, we charge the user each time they get information. We might charge for access the service, or just for access to certain "premium" services (such as Dilbert).

For advertisers, we charge for placing ads into user's newspapers. We can have several charging models:

- flat rate
- per placement: we know exactly how many newspapers the ad was placed in
- per access: we know how many times the page(s) with the ads were retrieved by users
- per referral: for ads that include hypertext links to more information, we can we can build a mechanism (see below) that allows us to measure how many users followed the ad links.
- commission: if we can trace the user's reading of the ad in our newspaper to the purchase of the product or service, we could charge a commission for the sale.

How to charge for referrals

Normally, for links pointing outside of our server, we don't know if the user clicked on the links or not.

However, by adding an additional level of indirection using HTTP's redirect operation, we can code each link through a tabulating machine. URLs might look like:

`http://link.openmarket.com/link/`

The link tabulator decrypts the real URL, records the usage to later bill the advertiser or service provider, and returns redirect reply to refer the user to the real service provider.

Relation To Dave's Active Advertising

This idea is similar to Dave's active advertising stuff: customers have profiles that filter out what they are interested in. It is a little more general, though; it isn't restricted to just advertising.

Also, the mechanics of the implementation are a little different (i.e. where the profiles reside), so the Custom HomePage service as proposed here might not be covered by the patent.

EXHIBIT B

From: Tom Levergood
Sent: Friday, June 02, 1995 5:36 AM
To: Bill Dally
Cc: tml@OpenMarket.com; gifford@lcs.mit.edu; morris@OpenMarket.com
Subject: Re: Session ID Patent

---boundary-LibPST-iamunique-769500843_ _ _
Content-type: text/plain

Bill,

Steve Morris and I read the patent app yesterday. Combined, we have a few comments to correct apparent errors. Can you give me a call Friday morning at your convenience? Thanks. (PS I have interviews between 10:00 and 11:15 so will most likely not be available during that period).

Thanks.
Tom